REMARKS

Claims 13 through 18 are pending in this application, of which claims 13 and 14 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. §1.142(b)[1]. Accordingly, claims 15 through 18 are active.

Specification

The Examiner objected to the specification requiring a statement of the lineage of this application. In response, the specification has been amended to provide lineage data as courteously suggested by the Examiner, thereby overcoming the stated basis for the objection. Accordingly, withdrawal of the objection is solicited.

Claims 15, 17 and 18 were rejected under 35 U.S.C. §102 for lack of novelty as evidenced by JP 10170955 (Ichimura et al.).

In the statement of the rejection, the Examiner referred to various Figures and paragraphs of Ichimura et al., asserting the disclosure of a display apparatus corresponding to that claimed. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc. 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); Crown Operations International Ltd. v. Solutia Inc., 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002).* In imposing a rejection under 35 U.S.C. §102 the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each and

[1] Claims 1 through 12 are cancelled at the time this application was filed.

every feature of a claimed invention. *In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).* That burden has not been discharged. Moreover, there is a significant difference between the claimed invention and the device disclosed by Ichimura et al. that scotches the factual determination that Ichimura et al. disclose a display device identically corresponding to that claimed.

Specifically, Applicants submit that the Examiner's reliance upon an interpretation of Fig. 2 of Ichimura et al. is misplaced. Clearly, the present invention is directed to a display device in which an optical element is provide on top of a wiring structure provided in a contact hole formed in the first and second insulating layers. A first metal layer, a wiring layer and a second metal layer are formed to cover the contact hole. The second metal layer is formed without any severance, by forming a step difference.

In contradistinction to the present invention, it should be apparent from Fig. 2 of Ichimura et al. that there is **no step difference** in the contact hole 23b provided in the SiO_2 film 18 and the SiN film 19. Moreover, nothing in the specification of Ichimura et al. mentions or remotely suggests the formation of a step difference.

The above argued **structure difference** between the claimed display apparatus and that disclosed by Ichimura et al. undermines the factual determination that Ichimura et al. disclose a display apparatus identifying corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc., 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).* Applicants, therefore, submit that the imposed rejection of claims 15, 17 and 18

under 35 U.S.C. §102 for lack of novelty as evidenced by Ichimura et al. is not factually viable and, hence, solicit withdrawal thereof.

Claims 15 and 17 were rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Kawasaki et al.

In the statement of the rejection, the Examiner referred to Figs. 2A and 2C of Kuwasaki et al., and to portions of the patent text, asserting the disclosure of a display apparatus corresponding to that claimed. This rejection is traversed.

As previously argued, the factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, supra; Crown Operations International Ltd. v. Solutia Inc., supra; Crown Operations International Ltd. v. Solutia Inc., supra.* When imposing the rejection under 35 U.S.C. §102 the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each and every feature of a claimed invention. *In re Rijckaert, supra; Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., supra.* That burden has not been discharged. Moreover, there is a significant difference between the claimed display apparatus and that disclosed by Kawasaki et al. that scotches the factual determination that Kawasaki et al. disclose a display device identically corresponding to that claimed.

Specifically, as clearly illustrated in Fig. 2 of Kawasaki et al., the contact hole provided in the protective insulating film and the interlayer insulating film 151 **lacks a step difference**. As previously argued, in accordance with the present invention, an optical element is provided

on top of wiring structure provided in a contact hole formed in the first and second insulating layers. A first metal layer, wiring layer and a second metal layer are formed to cover the contact hole. The second metal layer is formed without the occurrence of any severance, by forming **step difference.** No such step difference is disclosed or suggested by Kawasaki et al.

The above argued **structural difference** between the claimed display apparatus and that disclosed by Kawasaki et al. undermines the factual determination that Kawasaki et al. disclose a display apparatus identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc., supra; Kloster Speedsteel AB v. Crucible Inc., supra.* Applicants, therefore, submit that the imposed rejection of claims 15 17 under 35 U.S.C. §102 for lack of novelty as evidenced by Kawasaki et al. is not factually viable and, hence, solicit withdrawal thereof.

Claim 16 was rejected under 35 U.S.C. §103 for obviousness predicated upon Ichimura et al. in view of JP11-119900 Nakanishi.

This rejection is traversed. Claim 16 depends from independent claim 15. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 15 under 35 U.S.C. §102 for lack of novelty as evidenced by Ichimura et al. The secondary reference to Nakanishi does not cure the previously argued deficiency of Ichimura et al. Accordingly, even if the applied references are combined as suggested by the Examiner, and Applicants do not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).*

Applicants, therefore, submit that the imposed rejection of claim 16 under 35 U.S.C. §103 for obviousness predicated upon Ichimura et al. in view of Nakanishi is not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing, it should be apparent that the imposed rejections have been overcome and that all active claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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